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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,323	01/29/2004	Shinichi Namiki	MINB-02018/A-3165	1226
7590	02/16/2006		EXAMINER PHAN, THIEM D	
James E. Barlow Adduci, Mastriani & Schaumberg, L.L.P. 1200 Seventeenth Street, N.W. Washington, DC 20036			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,323

Applicant(s)

NAMIKI ET AL.

Examiner

Tim Phan

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicants' election of Group I-A, Claims 1-8, filed on 12/14/05 is acknowledged.

The Restriction mailed on 11/21/05 has been carefully reviewed and is held to be proper.

Applicants did not distinctly and specifically point out any logical error in the Restriction Requirement. Moreover, due to the lack of traversal on the merits, Applicants' election of Group I-A, claims 1-8, has been treated as an election without traverse.

Accordingly, Claims 9-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups, there being no allowable generic or linking claim.

The Restriction filed on 11/21/05 is hereby **made Final**.

Applicants are required to cancel these nonelected claim (9-17) or take other appropriate action.

An Office Action on the merits of Claims 1-8 now follows.

Title

2. The following title is suggested: "A Corrosion Prevention Method".

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **"insulation coating"** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. Figure 10 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 5, 15.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective

action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Heimann et al (US 6,455,100).

As applied to claim 1, Heimann et al teach a method for making and using coating composition for electronic components and other metal surfaces, comprising:

- stacking steel layers (Fig. 1, 5) to form a lamination;
- fixing the layers (Fig. 1, 5) to one another;
- vacuum impregnating (Col. 6, line 6) the lamination with an acrylic resin (Col. 2, lines 63 & 64; col. 3, lines 4 & 5), which has a high permeability, to fill gaps, which exist between the stacked layers (Col. 3, lines 23-26), with the acrylic resin;
- curing (Col. 6, lines 43-46) the acrylic resin; and

- applying an insulation coating (Col. 6, lines 10+) to the lamination.

As applied to claim 3, Heimann et al teach that the curing of the acrylic resin comprises immersing the lamination in warm water (Col. 9, lines 12-15).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heimann et al.

As applied to claim 2, Heimann et al teach a method for making and using coating composition for electronic components and other metal surfaces, which reads on applicants' claimed invention, including the step of applying vacuum pump to enhance the application method (Col. 6, lines 6 & 7), except for applying pressure inside the container.

It is mere matter of design choice to apply pressure inside the container to force the resin into the cracks of the lamination or area left by the bubble sucked out by vacuum pump, since it is known by basic laws of fluid mechanics that the fluid through vacuum-pressure is transmitted

to every portion of the fluid in the container and fills the cracks or areas left by the bubble and it appears that the invention would perform equally well without further applying pressure inside the container after the vacuum-pressure process.

As applied to claim 4, Heimann et al teach that the curing of the acrylic resin comprises immersing the lamination in warm water (Col. 9, lines 12-15).

10. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heimann et al in view of Riccio et al (US 4,714,623) or vice versa.

As applied to claims 5-7, Heimann et al teach a method for making and using coating composition for electronic components and other metal surfaces for corrosion prevention, which reads on applicants' claimed invention, except for applying a shot blasting treatment to the lamination after curing the resin.

Riccio et al teach a method for applying metal cladding on surfaces by sand or grit blasting (Abstract) on the surface of the cured resin to deposit a protective layer and to prevent electrolytic corrosion effects

It would be obvious to one of ordinary skill in the art at the time the invention was made to combine the two teachings by applying the sand blasting after the cured resin and the depositing of the protective layer, as taught by Riccio et al, to the method for using coating composition for metal surfaces, as taught by Heimann et al, in order to increase the strength of corrosion protection.

As applied to claim 8, Heimann et al teach a method for making and using coating composition for electronic components and other metal surfaces for corrosion prevention, which reads on applicants' claimed invention, except for applying an insulation coating by anion electro deposition.

Riccio et al teach a method for applying metal cladding on surfaces by sand or grit blasting (Abstract) on the surface of the cured resin to deposit a protective layer and to prevent electrolytic corrosion effects through plating (Col. 9, line 68) or electrodeposition.

It would be obvious to one of ordinary skill in the art at the time the invention was made to combine the two teachings by applying the sand blasting after the cured resin and the depositing of the protective layer through plating or electrodeposition, as taught by Riccio et al, to the method for using coating composition for metal surfaces, as taught by Heimann et al, in order to increase the strength of corrosion protection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M - F, 9AM - 5PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Phan
Examiner
Art Unit 3729

tp
February 9, 2006



A. DEXTER TUGBANG
PRIMARY EXAMINER